

## REMARKS

As an initial matter, applicant confirms the amendments made pursuant to the examiner's interview summary. For the convenience of the Office and applicant's reference, the amendments are indicated in this document

Claims 1, 7-8, 13-18 and 21-22 stand rejected under § 103 over Hazenfield in view of Hunter. The rejection is respectfully traversed.

The first issue that applicant objects to is the combination. The two references are so far afield from each other that the combination would require explicit teachings to meet the standards for the law of obviousness relating to combining the teachings of references. Hazenfield, as has been extensively discussed, concerns a telephone on-hold system. Hazenfield includes only pre-recorded messages, as discussed in column 4, lines 41-46. Hunter, in complete contrast, concerns a music distribution system that makes use of satellite TV set top boxes and the geostationary satellite used by Hughes and Echostar. This is discussed in column 6, lines 30-51.

The stated motivation has nothing to do with either of the references. The stated motivation is presented on page 3, and is: "It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hazenfield with Hunter's advertisement with music, in order to sale [sic] more music, with the advertisement in previewing." This stated motivation points to the fact that an artisan would never have been motivated to combine the references. Hazenfield has nothing to do with the sale of music. An artisan therefore would not be motivated to modify Hazenfield for the purpose of selling more music.

The attempt to combine the dissimilar references is clear evidence of the hindsight reconstruction being continually applied in the examination of this application. The presently claimed invention provides a messaging solution that is not apparent from the various collections of references that have been applied from the examiner. The references are stretched and interpreted in a manner contrary to their teachings, and a

prima facie case of obviousness has not been established.

As an example, the office action attempts to bend the new Hunter reference to meet the claimed method by making an inaccurate and unsupported statement regarding the CD device disclosed in Hunter. The office action states “the CD burner drive is inherently storing advertisement message from the downloading action. The user can play back the downloaded stored promotional message from the preview operation, and then purchase the music after preview.” (internal citations omitted). The CD burner in Hunter, as seen in FIG. 3 and as described in summary fashion in column 3 and in more detailed fashion in column 8, is not the device that receives preview information. As discussed in column 8, “The user station 28 will also contain an audio speaker system (not shown) to allow the customer to ‘preview’ the stored music before it is recorded permanently on a CD or other recordable median and subsequently paid for.” This contradicts the examiner’s statement that the “CD burner drive is inherently storing advertisement message from the download action.” It is unlikely that a user that is purchasing music for recording quality CD’s would want the music CD that is burned as a result of the purchase to include advertising messages. Someone purchasing music would not purchase the music to experience ads on the CDs that they are making, and Hunter recognizes this distinction.

Thus, the stated reason for the combination is both unsupported and illogical. In addition, it is contrary to the law. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. In re Sang Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002).

The examiner can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fritch, 972 F.2d 1260, 1265 (Fed.

Cir. 1992). The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. The need for specificity pervades this authority. In re Sang Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002).

More evidence of the inappropriate hindsight re-construction of the claimed invention is the pattern established during the prosecution of this application. The prosecution demonstrates a continually changing basis for obviousness in response to arguments, but arriving at the same overall conclusion. Previously, the Robbins patent had been applied. Presently, the Robbins patent has been replaced with Hunter. Switching prior art references in response to arguments "...simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability-the essence of hindsight." (Ecolochem, Inc. v. S. California Edison Co., 227 F.3d 1361, 1371 (Fed. Cir. 2000) quoting In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999)).

The above comments are applicable to all of the independent claims and the rejection as a whole. The previous responses are incorporated herein for commentary on Hazenfield and the other references that are applied and rejections of various ones of the dependent claims. The combination of the other references with the set top box satellite TV music purchasing system of Hunter is similarly without evidence and support.

Some additional comments concerning claim 1 are appropriate. Claim 1 requires playing promotional messages back "in response to a playback operation of the digital music player". Hunter does not teach this. The examiner misconstrues Hunter in on page 3 of the Office Action (and elsewhere): The user can playback the downloaded stored promotional message from the preview operation (FIG. 2, col. 3, lines 52-55; upper right corner of FIG. 10). The Examiner fails to distinguish between the promotional message and the music file the message is promoting. The preview information box in FIG. 2 refers to the music, not the promotional message. The upper right corner of FIG. 10 refers to the promotional message. At col. 13, lines 61-62 Hunter makes a distinction between the music and the promotional message or advertisement.


In Hunter, promotional messages are displayed automatically, not in response to a playback operation. As illustrated in FIG. 10, the promotional message is automatically displayed on the computer screen. Col. 13, line 36-43 of Hunter explicitly states that the system decides when to display an advertisement based on customer profiles, not a playback operation.

This is deemed a sufficient response to the outstanding office action. Separate patentability of all of the claims in view of the extended prosecution of this case and comments on the prior art of record is maintained. All of the rejections should be withdrawn. The examiner is invited to contact the undersigned attorney at the below-listed number to resolve any outstanding issues in this case.

Respectfully submitted,

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